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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,251	09/29/2000	Joseph P. Vadala JR.	T0428/7090 TJO/RHW	3371

7590 12/05/2002

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 12/05/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,251

Applicant(s)

VADALA ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-84 is/are pending in the application.
- 4a) Of the above claim(s) 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26-33 and 64-84 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 25 and 60-63 have been cancelled in the amendment received on 10/11/2002 and supplemental amendment 11/22/2002 respectively.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by LaMarca, II (US 5,456,976). LaMarca discloses every and single element of the claimed subject matter, a fabric layer A bonded to the foam layer B (figure 3).

Since LaMarca is using the same material and the same injection molding

dem process to form an article as Applicant, it is the examiner's position that the curved cross-section of the article would be inherently present. LaMarca anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-7, 12, 13, 20-24, and 27-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Keiser (US 5,851,617). Keiser discloses an article including a release liner sheet of microcellular foam material having an average cell size of less than 10 microns (see abstract) and a substrate joined to a surface of the release liner. See column 9, lines 1-19. Keiser discloses the label stock can be formed in the roll (column 7, lines 38-40). Likewise, it is clearly apparent that the label stock would have a curved cross-section as claimed by the present invention. The cell size range of the foam overlaps with the presently claimed ranges. Alternatively, for non-overlapping part of the ranges. However, such a variable would have been recognized by one skilled in the art to control the degree of porosity of the foam. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the microcellular foam having the cell size instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

It is the examiner's position that the article of Keiser is identical to or only slightly different than the claimed article prepared by the method of the claim, because

both articles use the same materials, having structural similarity (foam layer adhered to a substrate). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Keiser reference either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Keiser. With regard to claims 2 and 3, Figure 1 of Keiser shows that the substrate is a single layer and comprises a fabric material (column 3, line 65). With regard to claim 5, Keiser suggests the substrate is woven or nonwoven fabric formed of natural fibers and /or filaments (column 3, lines 62-63). With regard to claim 6, Keiser discloses the substrate comprises a plastic film (column 3, lines 61).

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With regard to claims 7 and 27, Keiser discloses the microcellular polymeric material is formed by using supercritical fluid such as CO₂, nitrogen, argon, helium (column 5, lines 8-13).

With regard to claims 12, and 13, Keiser teaches the polymeric material comprising polyethylene, acrylonitrile-butadienestyrene and substrate comprising polypropylene, polystyrene (column 5, line 47, and column 6, 25-45).

With regard to claim 22, Keiser discloses the substrate surface is embossed, colored or otherwise decorated (column 6, lines 60-61).

With regard to claim 29, Keiser teaches the substrate, itself, can be a sheet of microcellular foam material (column 5, line 47). The substrate is polymer foam (column 3, line 62). Therefore, it is the examiner's position that Keiser either anticipates or strongly suggests the claimed subject matter.

6. Claims 4, 9-11, 14-16, 17-19, 26, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser (US 5,851,617). Keiser discloses the substrate having a thickness of from 0.5 to 100 mm (0.02 to 3.94 inch). See column 5, lines 50-51. However, such a variable would have been recognized by one skilled in the art to control the degree of adherence of the substrate to the foam layer. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the substrate having the thickness instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art.

In re Aller, 105 USPQ 233.

With regard to claims 9-11, and 31-33, Keiser broadly suggests to use a polypropylene fabric with polypropylene microcellular (or any like combination). See column 3, lines 59-63. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a polypropylene fabric with polypropylene microcellular (or any like combination) motivated by the desire to obtain a laminate which could be easily recycled.

With regard to claim 16, Keiser discloses an article having a release liner/adhesive/substrate structure. See column 9, line 1. The substrate has a thickness of from 0.5 mm to 100 mm (0.02 inch to 3.94 inch). See column 5, lines 50-51. The release liner has a thickness of from 30 to 3000 nm. See column 5, line 28. It is the examiner's position that the article having a thickness of from 0.5 mm to 103 mm (0.02 inch to 4 inch). See obviousness rational for the thickness range with respect to claim 4 above.

With regard to claims 14 and 15, Keiser discloses the foam material provides a wide range of void fraction percentages from very high void fractions (low material density) up to 90%, or more, to very low void fractions (high material density) down to 20%, or less. See column 4, lines 57-61. The range disclosed by Keiser encompasses the claimed range.

With regard to claims 17-19, Keiser does not specially disclose the length-to-thickness ratio of the article. It would have been an obvious matter of design choice to have altered the length-to-thickness ratio of the article, since such a modification would have involved a mere change in the size of the article. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser (US 5,851,617) in view of Smorada et al (US 4,961,983). Keiser does not specially disclose a substrate being polypropylene fabric. Smorada teaches in analogous art, the substrate being polypropylene fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used polypropylene fabric as a substrate in the Keiser article motivated by the desire to provide the highest yield at the lowest cost.
8. Claims 1, 2, 6-21, 23, 24, 27, 31-33, 64, 65, 68-82 and 84 are rejected under 35 U.S.C. 103(a) as being obvious over Tupil et al (US 6,235,380).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to

subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Tupil teaches an article comprising a microcellular polymeric material having an average cell size of less than 100 microns and a substrate adhered to surface of the microcellular polymeric material (figure 7, column 4, lines 1-3). Tupil is silent as to the curved cross-section of the article. *In re Dailey*, 149 USPQ 47 (CCPA 1976), since no evidence of the record shows that the particular curved cross-section of article is significant or is anything more than one of numerous shapes, a person of ordinary skill in the art would find obvious for the purpose of providing the shape of the article. Therefore, the curved cross section of the article in itself would not render the claims patentable over Brunner. See *Graham v. John Deere Co.*,

Also see product-by-process rational in the paragraph no. 5.

With regard to claims 2, 6, 25, 65, and 68, Tupil teaches the article comprising a single layer of plastic film (column 2, line 63).

With regard to claims 7, 27, and 69, Tupil teaches the microcellular polymeric material is essentially free of any residual chemical blowing agent or reaction by-product of chemical blowing agent (column 6, lines 22-23).

With regard to claims 8, and 64, Tupil teaches the laminated article free of external adhesive (column 4, line 46).

With regard to claims 9-13, and 70-74, Tupil teaches the laminated article comprising a substrate being formed from a microcellular material (column 8, lines 19-21, and column 6, lines 15-20). It is the examiner's position that the substrate would inherently comprise a polymer having a softening temperature closed to that of the microcellular core material.

With regard to claims 14, 15, 75 and 76, Tupil teaches the microcellular material having a void fraction from 5% to 98%, the range disclosed by Tupil encompasses the claimed range of the present invention.

With regard to claims 16 and 77, Tupil discloses the article having a thickness of less than 0.15 inch (column 3, line 3).

With regard to claims 17-19, and 78-80, Tupil does not specially disclose the length-to-thickness ratio of the article. It would have been an obvious matter of design choice to have altered the length-to-thickness ratio of the article, since such a modification would have involved a mere change in the size of the article.

A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

With regard to claims 20, 21, 23-24, 81, 82 and 84, Tupil reads on the claim limitations (column 4, lines 18-20 and figure 7).

9. Claims 3-5, 22, 26, 66, 67 and 83 are rejected under 35 U.S.C. 103(a) as being obvious over Tupil et al (US 6,235,380) in view of LaMarca II (US 5,456,976).

Tupil is silent as to the fabric substrate adhered to the surface of the microcellular material. LaMarca II teaches a padded laminate comprising a foam layer B bonded to a fabric layer A that includes decorative feature (column 4, lines 30-49, and figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the plastic film layer with a fabric layer motivated by the desire to provide an aesthetically pleasing facing layer.

With regard to claims 4, 5, 26, 66 and 67, LaMarca II teaches the fabric material made of a polypropylene fabric (column 4, lines 40-42). None of the cited art discloses or suggests the thickness of the fabric layer. Thus, the skilled artisan must rely on his own knowledge. It would be obvious to one of ordinary skill in the art to employ as little of the layer of fabric as possible in order to reduce cost. Thus, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fabric layer having the thickness instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering

the optimum or workable ranges involved only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being obvious over LaMarca II (US 5,456,976). LaMarca is silent as to the thickness of the fabric layer. Thus, the skilled artisan must rely on his own knowledge. It would be obvious to one of ordinary skill in the art to employ as little of the layer of fabric as possible in order to reduce cost. Thus, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fabric layer having the thickness instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involved only routine skill in the art. *In re Aller*, 105 USPQ 233.

11. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being obvious over Kwiatek et al (US 5,629,014). Kwiatek discloses a transdermal patch having a curved cross-section and comprising a microcellular foam layer 12 adhered to a single cloth backing layer 16 (figure 1a, column 8, line 60) wherein the microcellular foam layer has the pore size of about 50 to 100 pores per linear inch (column 15, lines 53-55). Likewise, it is clearly apparent that the microcellular foam has the average pore size of 127 to 254 microns ($2R = 1\text{inch}$). However, such a variable would have been recognized by one skilled in the art to control the degree of porosity of the foam. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to employ the microcellular foam having the cell size instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regard to claim 26, Kwiatek is silent as to the thickness of the backing layer. However, such a variable would have been recognized by one skilled in the art to control the degree of adherence of the backing to the foam layer. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the backing having the thickness instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1, 2, 6-21, 23, 24, 27, 31-33, 64, 65, 68-82 and 84 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,235,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons listed in the paragraph no. 8.
14. Claims 3-5, 22, 26, 66, 67 and 83 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,235,380 of U.S. Patent No. 6,235,380 in view of LaMarca II (US 5,456,976). See discussion in the paragraph no. 9.

Response to Arguments

15. The art rejections over Keiser in view of Closson have been overcome by the present amendment and response.
16. The 102/103 art rejections over Keiser, the 103 art rejections over Keiser, the 103 art rejections over Keiser in view of Smorada have been maintained because of the following reasons. Keiser still reads on the claimed subject matter. Keiser discloses the label stock can be formed in the roll (column 7, lines 38-40). Likewise, it is clearly apparent that the label stock would have a curved cross-section as claimed by the present invention. The examiner wishes to point out that the curved cross-section of the article is not found to be limiting in ~~an~~ *a* patentable sense with respect to the article claimed since the curved cross section is merely related to a shape of the article and the shape of the article in

itself would not render the claims patentable over ~~Brunner~~. See **Graham v. John Deere Co.** *Kaiser*

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
November 27, 2002


TERREL MORRIS
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